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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,750	03/30/2004	Jurgen Dannenmaier	GAMBRO 3.3-254 CONT	4500
530	7590	01/04/2005	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/813,750

Applicant(s)

DANNENMAIER ET AL.9

Examiner

Krishnan S Menon

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-14.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

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Attachment to Advisory Action

The proposed amendments of 12/20/04 will not be entered because they raise issues of new matter as follows:

With the proposed amendment of claim 1, claim 4 raises issues of new matter. Claim 4 depends from claim 3, which in turn depends from claim 1. The newly added amendment to claim 1 requires **simultaneous sealing the entire length of the two portions of the housing and potting of the ends of the fibers in one step.**

Disclosure supporting this limitation of the claim is provided in paragraphs 0060 – 0062 on pages 15 and 16 of the specification. For this to happen, the ends of the fiber bundle must be severed between the adjacent filter housings on the winding wheel, the bundles with the housing portions clamped together and then centrifuged so as to spread the potting compound. Claim 3 recites the process on the winding wheel. Limitations recited in Claim 4, along with the newly added limitations of claim 1 require that the severing of the bundle happens **after** the potting. There is no disclosure in the specification or claims as originally filed for this limitation of claim 4, if the housing is sealed by the potting compound simultaneously with the ends of the bundle before severing the bundles. There is no disclosure of this, if it is interpreted as happening while on the winding wheel; it is not possible to do this if it requires centrifuging as described in the specification. Axis of rotation should be perpendicular to the longitudinal axis of the element to apply centrifugal force in the direction of the ends of the housing. Rotation of the winding wheel generates a centrifugal force in a direction

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perpendicular to the axis of the element, or perpendicular to what is disclosed in the specification.

Response to arguments:

Applicants argue that Oscarsson teaches assembling the two halves of the housing first and then does potting of the ends of the fibers. Applicants claim potting and sealing the housing simultaneously. However, unless there is a showing of new and/or unexpected results, the two methods would be deemed as an obvious change of order of process steps. Ex parte Rubin , 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.).

Applicants' argued advantage is that the number of steps in manufacturing is reduced by having to eliminate a severing step, and the simultaneous potting and sealing of the housing. The simultaneous sealing of the housing and potting of the bundle ends is not possible without removing the bundle from the winding wheel. Therefore, there is no eliminating-a-severing-step advantage.

A comparison analysis of the two processes as understood by the examiner:

Oscarsson teaches (1) winding the hollow fibers on the winding wheel to form the bundles, (2) **sealing** the housing sections 10a and 10b together, (3) severing the bundles between the housings to take them out of the winding wheel, (4) potting the bundle ends, and (5) cutting the bundle ends to open the hollow fiber ends.

Applicants' process has (1) winding the hollow fibers on the winding wheel to form the bundles, (2) **clamping** the housing portions together, (3) severing the bundles between the housings to take them out of the winding wheel, (4) simultaneously potting the bundle ends and the housing portions together, and (5) cutting the bundle ends to open the hollow fiber ends.

As one could see, Oscarsson teaches the sealing step while on the winding wheel (col 2 lines 60-62) and Applicants do not have an advantage because they have to clamp the housings together while on the winding wheel. Thus, there is no significant advantage of saving a step in the applicants' process when compared to the reference, except in claim 4. Such an advantage happens only in claim 4, wherein the step (3) is eliminated. However, elimination of step (3) is possible only if potting and sealing of the housing is done simultaneously, while on the winding wheel, *for which there is no disclosure in applicants' specification or claims as originally filed, and also because the potting and sealing is done simultaneously over a centrifuge (para 0061, page 16).*

Moreover, the teaching of Oscarsson in col 1 lines 20-42 says that Oscarsson's process is an improvement over the potting of the fibers while on the winding wheel. Thus, one

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could readily see that the possible process advantage touted by the applicants is anticipated by Oscarsson.

Now, regarding the argument that potting and sealing is done simultaneously in the applicants process, there is no real advantage, because Oscarsson does not need the sealing step while potting because the housing is already sealed. Moreover, Oscarsson anticipates potting and sealing (simultaneously) while on the winding wheel, as shown above. If applicants argue that there is an advantage of simultaneously potting and sealing ***after removal from the winding seal***, which is not taught by Oscarsson, applicants need to claim this process by providing sufficient non-obvious process steps in claim 1. Applicants disclose two different methods for sealing the housing, one is the welding (ultrasonic – page 15, paragraph 0058), and the other is the simultaneous potting. The two methods seem as equivalents (paragraph 0059: another possibility is ... the gluing together ...by means of the potting compound when potting the hollow fibers). Also, in paragraph 0021, page 6, applicants describe the sealing of the housing while on the winding wheel as preferred, which cannot happen if the sealing is done simultaneously with potting (no disclosure). Applicants need to provide evidence to show that they (welding vs simultaneous potting) are not obvious equivalents if they believe so. Also, Claim 1, if amended as proposed, would still be anticipated by Oscarsson because Oscarsson anticipates simultaneous potting of the fibers and sealing of the housing portions *while on the winding wheel*.

It may be noted that the examiner could not find sufficient disclosure in the applicants' specification and claims as originally filed for an interpretation of claim 4 that

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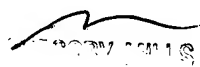
the simultaneous sealing the entire length of the housing and the potting of the fibers are done while on the winding wheel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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